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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/312,992	05/17/99	JOHNSTON S	

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QM02/0327

EXAMINER	
HOOK, J	
ART UNIT	PAPER NUMBER
3752	8

DATE MAILED:
03/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/312,992	Johnston
Examiner	**Group Art Unit**
James F. Hook	3752

☒ Responsive to communication(s) filed on *Jan 2, 2001* .

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-9* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-9* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by the Handbook of Steel Drainage. The reference to the Handbook of Steel Drainage discloses the recited spiral formed pipe comprising an elongated strip formed of ductile material such as sheet metal formed into adjacent helical convolutions, with a corrugated wall portion, seams which can be either lock seams or welded, where the dimensional proportions are increased along with pipe size, and where it is noted that conventional pipes of this type are capable of ranging in diameters from 6 inches to 21 feet in diameter, and can be formed into arch shapes of large diameters too as seen on page number 38.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-4 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Holcomb. The patent to Holcomb discloses the recited spiral formed pipe comprising an elongated strip formed of ductile material such as sheet metal formed into adjacent helical convolutions, with a corrugated wall portion 26, seams which can be either lock seams or welded, where the dimensional proportions are increased along with pipe size, and where it is taught that conventional pipes of this type are capable of ranging in diameters from 6 inches to 21 feet in diameter and it is implied that the pipe in Holcomb is made following these standards, and therefore it is believed that the pipe of Holcomb can also be made up to those dimensions if such were needed, where the dimensions are not considered limited by the examples tested in Holcomb.

5. Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holcomb in view of the Handbook of Steel Drainage. The patent to Holcomb discloses all of the recited structure with the exception of reshaping the tube as an arch. The reference to Handbook of Steel Drainage discloses the recited convoluted pipe formed of a ductile metal material can be made from tubes having large diameters which are either rounded in shape or can be formed in arch shapes, that such can be formed of the same types of pipes including seam welded and lock seamed pipes. It would have been obvious to one skilled in the art to modify the shape of the pipe

in Holcomb to be reshaped into an arch shape to provide a different profile which can be stronger as suggested by Handbook of Steel Drainage.

Response to Arguments

6. Applicant's arguments filed January 2, 2001 have been fully considered but they are not persuasive. The argument that Holcomb teaches only making the pipe in certain ranges is not considered persuasive since it is taught in Holcomb that the pipes disclosed therein can be made following the standards set in the Handbook of Steel Drainage, and therefor it is taught that the sizes of known pipes can be up to large diameters including up to 21 feet. The fact that Holcomb only tested pipes up to a certain sized and disclosed those results does not mean it is not obvious to make the pipe of larger diameters if needed, and that such is old and well known as taught by the Handbook that sizes can range up to 21 feet. With respect to the teachings of The Handbook of Steel Drainage, it discloses on page 8, first paragraph, that "steel conduits are available for many applications, in a wide range of sizes and shapes- round pipe in diameters of 6 inches to 24 feet and more, elliptical pipe, pipe arches, horseshoes, arches and other shapes" this clearly discloses that steel conduits can be formed in diameters larger than 15 feet, including in arch shapes. Further the table on page 38, and the description on page 40 state that pipes can be formed in round shapes up to 21 feet in diameter, and 20 feet 7 inches for arched conduits, where page 40 sets forth that this is true of lock seamed corrugated tubing. With respect to the

argument of hindsight for the Steel Drainage reference, such is not persuasive in that hindsight reasoning can only be applied to cases of obviousness, which refers only to rejections under 35 USC 103(a). In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Essentially, there is no claimed structure that differs from the references, and therefore a change in diameter is not a patentable feature, especially when references teach that pipes can be made larger than applicant's minimum diameter. It should also be noted that it is immaterial what apparatus is used or what method is used to make the article when claiming an article, only structure of the article itself is considered pertinent. Therefore, all the arguments set forth with regards to how the pipe is made on site, as well as by what type of apparatus the pipe is made, is immaterial to an article claim. It is also noted that these arguments are more detailed than the claim language. It is also not pertinent to argue the method in which the article is supplied to the work site, such is essentially the same as any other method claim in an article claim, it holds no patentable weight, and likewise it isn't part of the claim language either, therefore such is not a persuasive argument. The various uses for the article disclosed in the arguments is also immaterial when such is not being claimed, and are merely intended use, which

also adds no patentable weight for a known article meeting the claimed structure. It is also not persuasive that the Steel Drainage reference discloses other forms of the pipe such as twin structural plates, when it is clearly disclosed that the pipes are also made in spiral lock seam form, therefore even though the reference teaches other embodiments it does not prevent it from disclosing the embodiment claimed by applicant. With respect to Holcomb, tables A and B disclose the dimensions recited by the examiner in the rejection above, specifically with reference to ranges tested. It is also not hindsight to use a reference mentioned in Holcomb itself, and where Holcomb discloses that the reference teaches various aspects of the pipes made including the dimensions thereof, therefore the Holcomb clearly teaches the combination of the references. With respect to the argument that Holcomb teaches away from larger diameter pipes, the argument that tested ranges are not necessarily limiting responds to this argument, see above.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Hook whose telephone number is (703) 308-2913.

J. Hook
March 26, 2001

James F. Hook
James F. Hook
Primary Examiner
Art Unit 3752